

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1-11 will have been canceled and claims 12-17 will have been submitted for consideration by the Examiner. In view of the above, Applicants respectfully request reconsideration of the outstanding objection and rejections of the all claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided as well as for the acknowledgment of Applicants' Claim for Priority under 35 U.S.C. § 119 and receipt of the certified copy of the priority document, as set forth in the Official Action. However, Applicants note that the priority document was filed in the present application, rather than in the "parent" application. The application number and filing date noted by the Examiner are in fact of the present application.

Applicants further note with appreciation the Examiner's acknowledgment of Applicants' Information Disclosure Statement filed in the present application on March 8, 2002 by the return of the initialed and signed PTO-1449 Form, and for consideration of the documents cited in the Information Disclosure Statement.

Applicants note the Examiner's objection to the declaration and traverse the same. The declaration is not defective. The executed declaration was filed with the application and thus cannot have an application number or filing date therein. Regarding the dating of the signatures, the Examiner's attention is respectfully directed to MPEP § 602.05.

Turning to the merits of the action, the Examiner has objected to the specification under 35 U.S.C. § 112, first paragraph, because the specification does not comply with 35 U.S.C. § 112, first paragraph. Applicants have amended the specification to comply with 35 U.S.C. § 112, first paragraph. Thus, Applicants respectfully request that the Examiner withdraw the objection.

The Examiner has rejected claims 1-7, and 9-11 under 35 U.S.C. § 102(e) as being anticipated by RANALLI et al. (U.S. Patent No. 6,748,057). The Examiner also has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over RANALLI et al. in view of GOODMAN (U.S. Patent No. 6,735,617).

However, Applicants respectfully traverse the above rejections.

As noted above, Applicants have canceled claims 1-11 and have submitted claims 12-17 for consideration by the Examiner. Applicants respectfully traverse the above rejections based on claims 12-17 and will discuss said rejections with respect to the pending claims in the present application as will be set forth herein below. The newly submitted claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicants' claims 12-15 generally relate to a server apparatus connected to a transmitting IP apparatus. The transmitting IP apparatus transmits an e-mail to a receiving IP apparatus via the server apparatus. The server apparatus comprises a memory which stores an IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus. The server apparatus comprises a receiver which receives the e-mail from the transmitting IP apparatus. The e-mail includes the telephone number of the receiving IP apparatus. The server apparatus

further comprises a controller which obtains, from the received e-mail, the telephone number of the receiving IP apparatus, obtains, from the memory, the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, and transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus. Claim 16 recites a related system. Claim 17 recites a related method.

On the contrary, RANALLI et al. relates to a method for contacting an end user on the Internet. RANALLI et al. comprises a first communication system (CS-1) 2 which serves a first end user (EU-1). The first communication system (CS-1) provides a telephone number of a second end user (EU-2) to a directory service (DS) 12. The directory service (DS) 12 comprises a compilation of telephones numbers and associated Internet address of end users. The first communication system (CS-1) contacts directory service (DS) 12 to request an Internet address of a second communication system (CS-2), based on the a telephone number of a second end user (EU-2) which serves a second end user (EU-2). The first end user (EU-1) contacts the second end user (EU-2) via the Internet, based on the associated Internet address of the second communication system (CS-2). If an Internet address is not available, the call is completed via the PSTN 8 (col. 2, lines 59-67 and col. 3, lines 1-2).

However, RANALLI et al. does not disclose a server which receives an e-mail from a transmitting IP apparatus and which transmits the received e-mail to a receiving IP apparatus, since the first end user (EU-1) contacts (i.e., sends a message) the second end user (EU-2) via the Internet without the directory service (DS) based on the Internet address of the second communication system (CS-2) after the first end user

(EU-1) obtains, from the directory service (DS), the Internet address of the second communication system (CS-2).

In other words, the first end user (EU-1) enters the telephone number of the second end user (EU-2) in the first communication system (CS-1) 2 via a key pad 5 (col. 2, lines 59-64), and the first communication system (CS-1) 2 transmits, to the directory service (DS), a "request" for the Internet address of the second communication system (CS-2) 4 (col. 2, lines 36-40). Then, the directory service (DS) "returns", to the first communication system (CS-1) 2 (IP-PBX A (26)), an IP address for a destination communication system (col. 8, lines 5-12, and col. 8, lines 19-21). However, an e-mail containing the telephone number of the receiving IP apparatus is not received by the directory service (DS).

Further, RANALLI et al. does not disclose an e-mail which includes a telephone number of a receiving IP apparatus in the e-mail.

Thus, RANALLI et al. does not disclose a server apparatus which receives the e-mail including the telephone number of the receiving IP apparatus, obtains, from the received e-mail, the telephone number of the receiving IP apparatus, and transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, as recited.

Rather, in RANALLI et al., the first communication system (CS-1) 2 transmits, to the directory service (DS), a "request" for the Internet address of the second communication system (CS-2) 4, and the directory service (DS) "returns", to the first communication system (CS-1) 2 (IP-PBX A (26)), an IP address for a destination

P20705.A02

communication system, in response to the "request" (col. 2, lines 36-40, col. 8, lines 5-12, and col. 8, lines 19-21). Then, the first end user (EU-1) contacts the second end user (EU-2) via the Internet, based on the associated Internet address of the second communication system (CS-2) (col. 3, lines 1-2).

Thus, RANALLI et al. does not disclose a server apparatus which receives the e-mail including the telephone number of the receiving IP apparatus, obtains, from the received e-mail, the telephone number of the receiving IP apparatus, obtains, from the memory, the IP address of the receiving IP apparatus corresponding to the telephone number, and transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

Thus, since RANALLI et al. does not comply with the recitations of the pending claims, the pending claims are clearly distinguished over RANALLI et al.

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 12-17 are not disclosed in RANALLI et al. cited by the Examiner.

GOODMAN relates to a system in which when the sender's computer 920 sends a facsimile message to the recipient's facsimile machine 975, and the facsimile message is sent from the sender's computer 920 to the sender's mail server 930. An address of the recipient's facsimile machine 975 includes a telephone number of the recipient's facsimile machine 975 and a domain name of the facsimile mail server 950. The sender's mail server 930 obtains an IP address of the facsimile mail server 950 from the DNS server 945, based on the domain name of the facsimile mail server 950. The sender's mail server 930 forwards the facsimile message to the facsimile mail server 950, based on the IP address of the facsimile mail server 950. The facsimile mail

P20705.A02

server 950 selects a gateway to which the facsimile message should be forwarded and forwards the facsimile message to the selected gateway. The gateway is selected, based on loads on different gateways at a time when the facsimile communication is forwarded. Ultimately, the facsimile message is delivered from the selected gateway to the recipient's facsimile machine 975 over a "conventional telephone network" 970 (col. 6, lines 54-67 and col. 7, lines 1-33).

However, in GOODMAN, the facsimile message is delivered to the recipient's facsimile machine 975 over a "conventional telephone network" 970. Thus, the recipient's facsimile machine 975 does not have an IP address. In other words, GOODMAN does not disclose a memory which stores an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus. Thus, GOODMAN cannot obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number and can not transmit the received e-mail to the receiving IP apparatus, based on the obtained IP address of the receiving IP apparatus.

Thus, GOODMAN additionally cannot disclose a server apparatus which stores an IP address of the receiving IP apparatus associated with a telephone number of the receiving IP apparatus. GOODMAN also does not disclose a server apparatus which obtains, from the received e-mail, the telephone number of the receiving IP apparatus, obtains, from a memory, the IP address of the receiving IP apparatus associated with the telephone number, and transmits the received e-mail to the receiving IP apparatus, based on the IP address of the receiving IP apparatus.

Additionally, Fig. 13 of GOODMAN shows a gatekeeper lookup table which contains zones, gateway addresses, and gateway priority. However, none of these teach an IP address of the receiving IP apparatus associated with the telephone number of the receiving IP apparatus, since the facsimile message is delivered to the recipient's facsimile machine 975 over a conventional telephone network 770.

Thus, GOODMAN does not comply with requirements, recited in the pending claims, so the pending claims are clearly distinguished over GOODMAN.

Therefore, it is respectfully submitted that the features recited in Applicants' submitted claims 12-17 are not disclosed in GOODMAN cited by the Examiner. The pending claims are also submitted to be patentable over the Examiner's proposed combination, since neither of RANALLI et al. and GOODMAN, nor any proper combination thereof, disclose the combination of features recited in Applicants' claims 12-17.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding objection and rejections, and an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have canceled the rejected claims and have submitted the new claims for consideration by the Examiner.

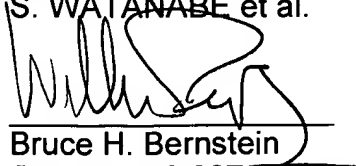
With respect to the rejected claims, Applicants have pointed out the features thereof and have contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

April 21, 2005
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Respectfully submitted,
S. WATANABE et al.


Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630